

REMARKS

This responds to the Final Office Action mailed on October 10, 2008.

Claims 1, 9 and 18 are amended, claims 6, 14 and 23 are canceled without prejudice or disclaimer; as a result, claims 1-5, 7-13, 15-22 and 24-25 are now pending in this application. The amendments to claims 1, 9 and 18 incorporate the subject matter of claims 6, 14 and 23 respectively. Therefore the amendments do not introduce any material that would require a new search. Entry of the amendments is therefore believed appropriate.

§103 Rejection of the Claims

Claims 1-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Coss in view of Moir (U.S. 2002/0120720 A1) in view of Venkatachary, and further in view of Katz.. The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made

explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)). Applicant respectfully submits that the claims contain elements not found in the combination of Coss, Venkatachary and Katz, therefore the claims are not obvious in view of the combination.

For example, claims 1, 9 and 18 as amended recite that the “the at least one action comprises saving the result of the at least one action for use in a later executed rule in the set of parsed protocol state rules.” With respect to now canceled claims 6, 14 and 23, the Office Action states that “Coss teaches that the results of the rule are stored in cache and that the results of the rule are then applied to a later received similar packet that would have used that same rule (column 5, lines 40-50).” Applicant respectfully disagrees with this interpretation of Coss. The cited section of Coss states:

Stateful packet filtering may be implemented by caching rule processing results for received packets, and then utilizing the cached results to bypass rule processing for subsequent similar packets. For example, the results of 45 applying a rule set to a packet of a given network session may be cached, such that when a subsequent packet from the same network session arrives in the firewall, the cached results from the previous packet are used for the subsequent packet. This avoids the need to apply the rule set to each 50 incoming packet, and thereby provides substantial performance advantages over conventional firewalls. (emphasis added)

It is clear from the language cited in the Office Action that while Coss may save data, it is not saving data for use in a later executed rule as recited in Applicants' claims 1, 9 and 18. Instead, Coss saving the results to *bypass* rule processing, not for use in a later executed rule. Coss specifically states that the application of the rule set is avoided using the cached result. If rule processing is bypassed and application of the rule set is avoided, it is impossible for the result to be used in a later executed rule. Applicant has reviewed Venkatachary, Moir and Katz and can find no teaching or suggestion of saving the result of the at least one action for use in a later executed rule. Thus the combination of Coss, Venkatachary, Moir and Katz fails to teach or suggest each and every element of claims 1, 9 or 18 resulting in differences between the claimed invention and the combination of Coss, Venkatachary, Moir and Katz. Therefore claims 1, 9 and 18 are not obvious in view of the combination. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1, 9 and 18.

Further, Coss teaches away from Applicant's claimed invention. As discussed above, Applicants claims 1, 9 and 18 recite saving the results of a rule for use in a later executed rule. In contrast, Coss teaches that it is desirable to avoid rule processing by using a cached rule result to bypass rule set execution. Therefore Coss teaches away from Applicants' claimed invention. As a result, there is no motivation to combine Coss with Venkatachary, Moir and Katz.

Additionally, "[a] factfinder should be aware. . . of the distortion caused by hindsight bias and must be cautious of argument reliant upon *ex post* reasoning." *KSR Int'l Co.* at 1397. *See also Graham* at 474. The Examiner cannot use the Appellant's structure as a "template" and simply select elements from the references to reconstruct the claimed invention. *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991).

The Office Action uses four references in the rejection of claims 1-25. This is highly suggestive that the Examiner is using Applicants' structure as a template and selecting individual elements from each reference in a hindsight reconstruction of Applicants' claimed invention. Further, the use of individual elements from four references suggests that the Examiner is merely considering whether the differences are obvious, not the invention as a whole.

For all of the reasons above, Applicants respectfully submit that the combination of Coss, Venkatachary, Moir and Katz does not teach or suggest each and every element of claims 1, 9 and 18 and that there is no motivation to combine Coss, Venkatachary, Moir and Katz. Therefore claims 1, 9 and 18 are not obvious in view of the combination. Applicants request reconsideration and the withdrawal of the rejection of claims 1, 9 and 18.

Claims 2-5 and 7-8 depend from claim 1, claims 10-13 and 15-17 depend from claim 9 and claims 19-22 and 24-25 depend from claim 18. These dependent claims are therefore patentable over Coss, Venkatachary, Moir and Katz for at least the reasons argued above, and are also patentable in view of the additional elements which they provide to the patentable combination. If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is also nonobvious. MPEP § 2143.03.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's representative at (612) 373-6954 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6954

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By 

Rodney L. Lacy

Reg. No. 41,136

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 12, 2009.

Name Amy Moriarty

Signature 